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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,461	07/09/2001	John David Walker	4531.002	5647
27325	7590	01/05/2005	EXAMINER	
DAVID P. LHOTA, ESQ.			UNGAR, DANIEL M	
STEARNS WEAVER MILLER WEISSLER				
ALHADEFF & SITTERSON, PA			ART UNIT	PAPER NUMBER
200 EAST BROWARD BOULEVARD, SUITE 1900			2132	
FORT LAUDERDALE, FL 33301				DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/901,461	WALKER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Daniel M. Ungar	2132	

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 July 2001.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-15 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 09 July 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                             |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                        | 6) <input type="checkbox"/> Other: _____                                    |

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**DETAILED OFFICE ACTION**

1. Claims 1-15 have been examined,

**PRIORITY**

2. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(e). The certified copy has been filed in parent Application No. 60/217,763, filed July 12, 2000.

**DRAWINGS**

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Internet 14 (page 5, line 11), Item 112 (page 8, line 8).
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "11" has been used to designate both "hand-held processor" (page 5, line 8) and "other wireless device" (page 6, line 16) and "housing" (multiple places).
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "114" has been used in Figure 5 to designate both "Valid?" and "Select database...".

**CLAIM OBJECTIONS**

6. Claim 3 is objected to for the following informality: "digital" is misspelled.
7. Applicant is advised that should claim 13 be found allowable, claim 14 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

**CLAIM REJECTIONS - 35 U.S.C. 112**

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1 is rejected under 112, second paragraph, as being indefinite. As the claim currently reads, it is the digital fingerprint profile that is received. It is unclear how the fingerprint means can both receive and create a digital fingerprint profile. For the purposes of this Office Action the claim is interpreted to mean that the detected *fingerprint* is received (and processed), and the digital fingerprint *profile* is created and outputted. Appropriate correction is required.

10. Further, in claim 1, it is unclear how the database can store already previously stored profiles. Appropriate correction is required.

11. Further, claim 1 recites the limitation "said microprocessor", for which there is insufficient antecedent basis.

12. In claim 2, It is unclear whether the wireless communication link is in addition to the telecommunication means of claim 1, or whether the telecommunications link of claim 1 is further defined to be wireless.

**CLAIM REJECTIONS - 35 U.S.C. 102**

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 8, 9, 11, 13, and 15 are rejected under 35 U.S.C. 102(a) as being anticipated by Maes et al., U.S. Patent Number 6,016,476.

14. Regarding claim 1, Maes et al. disclose a fingerprint authentication and communication apparatus including

fingerprint means for receiving, processing, creating, and outputting a digital fingerprint profile (see abstract; column 3, line 21; column 5, lines 11-24; column 5, lines 54-67; claims 4 and 5);

a processor in electrical communication with said fingerprint means (see column 5, lines 11-24; figure 1, item 22);

a user interface (see column 3, lines 16-22; column 5, 36-42; figure 1, item 34);

storing a plurality of fingerprint profiles in a database for subsequent retrieval (see column 5, lines 21-24);

reading a digital fingerprint profile, determining if it is in the database and valid, and authorizing said user inputs for initiating a user command (see column 5, lines 54-63; claims 4 and 5);

a telecommunication means for transmitting user commands to a predetermined location accessible over a telecommunications network for fulfilling said user command (see abstract; column 6, lines 1-27; column 7, line 57 - column 8, line 27).

15. Regarding claim 2, Maes et al. disclose a means for communicating with a predetermined location through a wireless communication link (see column 6, lines 8-27).

16. Regarding claim 8, Maes et al. disclose means for ordering goods and services from a remote location through telecommunications means (see claim 14; column 12, lines 5-15).

17. Regarding claim 9, Maes et al. disclose voice commands and "operations of the PDA device via programs stored in a memory and executed by the CPU" (see column 5, lines 1-11), meeting the limitation of a database of commands and actions.

18. Regarding claim 11, Maes et al. disclose a key pad for a user interface (see column 5, lines 40-41).

19. Regarding claim 13, Maes et al. disclose a means for communicating with a printing device (see column 6, lines 1-8).

20. Regarding claim 15 (14?), Maes et al. disclose communicating with a land line telecommunications system (see column 7, line 57 – column 8, line 11).

***CLAIM REJECTIONS – 35 U.S.C. 103(a)***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maes et al. in view of Schmitt et al., U.S. Patent Number 6,088,585. While Maes et al. disclose the fingerprint means, "[a] biometric sensor of any conventional type may also be provided for collecting biometric data [...] such as a finger, thumb or palm print" (column 5, lines 54-57), they are silent as to the details of how the sensor works. Nevertheless, obtaining an image of a fingerprint placed on the sensor and converting fingerprint input to a digital fingerprint profile was a well-known means in the art. This is exemplified by Schmitt et al. who, in a similar field of endeavor, disclose a telecommunications apparatus with a fingerprint sensor that obtains an image of a fingerprint and means for converting a fingerprint input to a digital fingerprint profile (see column 8, lines 57-64; column 9, lines 36-50). Given the teachings of Schmitt et al. it

would have been obvious to one of ordinary skill in the art at the time of the invention to have used this means to detect a fingerprint to efficiently capture a fingerprint profile.

23. Claims 4, 5, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maes et al., as established above, in view of Mayaud, U.S. Patent Number 5,845,255.

24. Regarding claim 4, although Maes et al. disclose that “[i]t is to be appreciated that the present invention may be used to store and access personal information such as medical” (see column 11, line 58 – column 12, line 4), they fail to provide the details of its use in the medical field in same manner as in claims 4-7. However, in a similar field of endeavor, Mayaud discloses an apparatus with a handheld device comprising a database with medical information related to predetermined patients (see column 7, lines 49-67; claim 6). Note further that Mayaud discloses fingerprint authentication (see column 17, lines 54-59).

25. With regard to claim 5, Mayaud discloses a database comprising information related to predetermined facilities that are in predetermined medical related industries (see column 7, lines 53-57).

26. With regard to claim 6, Mayaud discloses means for ordering medical prescriptions from a remote location through telecommunications means (see abstract; column 27, lines 30-50; claim 20).

27. With regard to claim 7, Mayaud discloses means for ordering medical laboratory tests from a remote location through telecommunications means (see column 51, line 49 – column 52, line 11).

28. Note that like Maes, et al., Mayaud discloses a handheld device / PDA capable of effecting the disclosed telecommunications transactions (see column 7, lines 57-67), and thus it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the apparatus of Maes, et al. to access the medical information and order medical

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prescriptions and lab tests in the manner described by Mayaud to meet the medical community's needs.

29. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maes et al., as established above, in view of Ausems et al., U.S. Patent Number 6,434,403. Maes et al. fail to disclose a database for storing an electronic calendar and synchronizing information stored within with a computer. However, including an electronic calendar as part of a PDA and synchronizing information between a PDA and a computer were well known in the art at the time of the invention. This is exemplified by Ausems et al. who, in a similar field of endeavor, disclose a PDA / telecommunications device that does comprise calendar functions (see column 3, line 9), meeting the limitation of claim 10, and does link to a computer for synchronizing information (see abstract; column 3, lines 58-64), meeting the limitation of claim 12. Note that Ausems et al. also disclose the use of fingerprint detection to determine if one is authorized to use the apparatus (see column 8, lines 63-67; figure 3, item 350; claim 20). Given the teachings of Ausems et al. it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the apparatus of Maes et al. to include an electronic calendar to organize one's schedule and include synchronization means with a computer, both common functions of handheld devices such as disclosed by Maes et al.

## **CONCLUSION**

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M. Ungar whose telephone number is 571.272.7960. The examiner can normally be reached on 8:30 - 6:00 Monday - Thursday, Alt. Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571.272.3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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